

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUERGEN HAGEDORN
and MANFRED HARTMANN

Appeal No. 1998-0273
Application 08/285,892

ON BRIEF

Before WARREN, OWENS and LIEBERMAN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief, and based on our review, find that we cannot sustain the rejection of appealed claims 11 through 30,¹ all of the claims in the application, under 35 U.S.C. § 103 as being unpatentable over Hare or Xerox in view of Reed et al.

¹ See, e.g., the amendments of August 4, 1994 (Paper No. 15), and November 20, 1995 (Paper No. 17).

(Reed) or Klinker et al. (Klinker).² We can sustain the rejection of appealed claim 14 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.³

It is well settled that “[t]he consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the claimed process] should be carried out and would have a reasonable likelihood of success viewed in light of the prior art. [Citations omitted] Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant’s disclosure.” *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Thus, a *prima facie* case of obviousness is established by showing that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants’ disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Micro Chemical Inc. v. Great Plains Chemical Co.*, 103 F.3d 1538, 1546, 41 USPQ2d 1238, 1244-45 (Fed. Cir. 1997); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *Dow Chem.*, 837 F.2d at 473, 5 USPQ2d at 1531-32.

379 F.2d 1011, 1014-17, 154 USPQ 173, 176-78 (CCPA 1967).

The plain language of appealed claims 11, drawn to a method of transferring an image onto a backing of textile fabric, specifies a transfer sheet consisting essentially of at least a plain paper substrate, which does not have a release treatment or coating applied thereto, and a transfer coating of thermoplastic polymeric film material bonded to one side of the plain paper substrate, wherein a toner image can be formed on and fused onto the thermoplastic film, and no adhesive overcoating or solvent layer is on the thermoplastic film. In similarly plain language, a transfer sheet consisting essentially of the

² Answer, pages 4-5.

same elements is specified in appealed claim 17, drawn to that transfer sheet. It seems to us that the examiner's position is that one of ordinary skill in this art would have found in the teachings of Reed, wherein the transfer sheet can be an image printed on plain paper that is overcoated with an adhesive, and of Klinker, wherein the transfer sheet can be a plain paper coated with a release layer and then a sandwich of primer, image and adhesive overcoat layers, the motivation to use plain paper instead of release paper in the transfer sheets of Xerox, wherein a polymer coated on the release paper receives an image from a copy machine, and of Hare, wherein the release paper is coated first with an adhesive polymer layer and then with a layer of resin and abrasive particles which receives the image, with the expectation of avoiding the expense of a release coating, a desideratum in the art as discussed in Reed (col. 1). We cannot agree.

As pointed out by appellants in the brief and reply brief, each of Hare, Reed and Klinker disclose transfer sheets of a different structure than that claimed and include at least one component that is specifically excluded from the claimed transfer sheet. The only transfer sheet which has a structure that resembles the claimed transfer sheet and actually differs solely from the claimed transfer sheet by the use of release paper instead of plain paper is disclosed by Xerox. We find that the examiner has failed to establish by evidence or scientific explanation why a transfer sheet which requires an adhesive overcoat on printable paper or a transfer sheet that requires a release coating on paper would have suggested that such plain paper could replace the release paper used with the particular polymer in Xerox. Indeed, the examiner has not shown that one of ordinary skill in this art would have recognized that the relationship between the paper and the coatings thereon in Reed and Klinker would exist between plain paper and the image receiving polymer in Xerox, such that the interchange would result in an operable transfer sheet, that is, the modification would not render the transfer sheet of Xerox inoperable to function in the intended manner. Furthermore, even if the examiner did provide a showing with respect to the transfer sheet of Hare, the interchange of the release paper of this transfer sheet with plain paper still would not have resulted in the transfer sheet specified in claims 11 and 17.

³ Answer, pages 3-4.

Accordingly, we reasonable inferred from this record that the examiner has indulged in hindsight and therefore reverse this ground of rejection. *See Rouffet, supra* (“hindsight” is inferred when the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellants’ claimed invention has not been explained).

Turning now to the ground of rejection under § 112, second paragraph, the initial burden of establishing a *prima facie* case on any ground under the second paragraph of § 112 rests with the Examiner. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), *citing In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (“As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.”). In making out a *prima facie* case of non-compliance with this statutory provision on the basis that a claim is indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention, the examiner must establish that when the language of the appealed claims is considered as a whole as well as in view of the written description in the specification as it would be interpreted by one of ordinary skill in the art, the claims in fact fail to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). In other words, the operative standard for determining whether § 112, second paragraph, has been complied with is “whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *See The Beachcombers, Int’l. v. WildeWood Creative Prods.*, 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994), *quoting Orthokinetics Inc v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

In the present case, three range limitations in claim 14 are prefaced with the language “a preferred,” which language also appears in the written description in the specification.⁴ In context, the use of the indefinite article “a” clearly indicates that there are other “preferred” ranges. Indeed, contrary to appellants’ argument (brief, pages 10-11), the entire phrase must be interpreted in each instance and

⁴ See the preliminary amendment of August 4, 1994 (Paper No. 15; paragraph bridging pages 5-6).

not merely the “preferred” part thereof. Thus, we agree with the examiner because we determine that one skilled in the art would not understand what is claimed even in light of the specification.

While we affirm this ground of rejection, we note appellants’ intent to amend the claim (reply brief, page 3), and thus we are of the view that, under the facts of this case, appellants shall have the right to amend claim 14. 37 CFR § 1.196(c) (1997).

The examiner’s decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

CHARLES F. WARREN)	
Administrative Patent Judge)	
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TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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